

REMARKS

Prior to the issuance of the Office Action of March 6, 2003, to which this Response is directed, Applicants note that claims 1-35, 39-41, 43, 61-95, 100-104, 110, 111 and 115-170 were pending. All of these claims remain pending in the present matter after entry of this Response. Further, Applicants note and extend their gratitude to the Examiner for indicating that Claim 111 has been allowed. Also, Applicants thank the Examiner for realizing that the Palmer reference is not valid prior art to any of the claims currently pending in the present matter.

Applicants further desire to note that all of the pending claims, except claim 111, have been rejected by the Examiner based upon the Schein reference. As such, Applicants respectfully traverse all such rejections based upon Applicants' contention, as set forth in greater detail hereinbelow, that just as the Palmer reference was not valid prior art, the Schein patent also does not constitute valid prior art.

Rejection Under 35 U.S.C. 102(e)

The Examiner rejected claims 1, 4-14, 16-19, 21-35, 39-40, 43, 61, 64-74, 76-79, 81-95, 100-101, 103-104 and 115-140 under 35 U.S.C. 102(e), as being anticipated by United States Patent Number 6,002,394, which issued to Schein et. al. (hereinafter, "the Schein Patent") on December 14, 1999.

Prosecution History/Claimed Priority of the Schein Patent

As stated on the face of the Schein Patent, the application that eventually issued as the Schein Patent (hereinafter, the "Schein D" reference) was filed on April 11, 1997 as a continuation-in-part of U.S. patent application serial number 08/537,650, which was filed on October 2, 1995 and is now abandoned (hereinafter, the "Schein A" reference). Further, the Schein D reference also claims priority to U.S. provisional patent application serial number 60/015,648, which was filed on April 19, 1996 (hereinafter, "Schein B"), and to U.S. provisional patent application serial number 60/022,826, which was filed on July 26, 1996 (hereinafter, "Schein C").

Applicants respectfully note that the only Schein reference which predates the pending claims in the present application is Schein A, because the subject matter set forth in the claims pending in the present application claim priority to U.S. patent application serial no. 08/613,144, which was filed on March 8, 1996 and/or to U.S. patent application serial no. 08/615,143, which was filed on March 14, 1996; both of which predate the filing date of both the Schein B and Schein C provisional applications. As such, in light of the fact that the Schein D application was filed AFTER the earliest claimed priority date of March 8, 1996 for the present matter, Applicants contend that the Schein Patent can only be used as prior art under 35 U.S.C. 102 or 103 if the claimed invention in the Schein Patent (as set forth by the issued claims) is described and enabled (as required by 35 U.S.C. 112, ¶ 1) by an application filed prior to March 8, 1996. Applicants contend that such a showing cannot be made, and that the Schein Patent cannot properly be used as a prior art reference.

35 U.S.C. 102(e) Ref. Must Satisfy Written Description and Enablement Requirements

As argued previously in the Response of November 7, 2002, Applicants reassert their contention that in order for a reference to be entitled to filing date of an earlier filed application to which a claim of priority has been made, and specifically for purposes of being utilized as prior art under 35 U.S.C. 102(e), the earlier filed application MUST satisfy the priority requirements of 35 U.S.C. 120. 35 U.S.C. 120 further requires compliance with the written description and enablement requirements, as set forth in 35 U.S.C. 112, ¶ 1, for the invention claimed in the issued patent. If necessary, Applicants respectfully request the Examiner to review their Response of November 7, 2002 wherein the basis for the Applicants' position is more fully set forth.

But, in the interest of brevity, Applicants refer the Examiner to 37 C.F.R. 1.53(b) which has been interpreted by the Board of Patent Appeals and Interferences, in *Ex Parte Craig Heikes*, 2002 WL 31003035 (Bd. Pat.App & Interf.), as providing that "the determinative question [as to whether a patent is entitled to an earlier priority date] is whether the invention claimed in the patent finds a supporting disclosure, in the patent's application in question, in compliance with section 112, as required by section 120, so as to entitle that invention as 'prior art' to the filing date of the patent's application. The only date a patent has under 102(e)(2) is the filing date of

the application on which the patent issued. ‘**Any earlier U.S. filing date for the patent necessarily depends on further compliance with §§120 and 112.**’ *Wertheim*, 646 F.2d at 538, 209 USPQ at 565.” (*Ex Parte Craig Heikes*, at pg. *3 (emphasis in original)). Applicants also refer the Examiner to the Manual of Patent Examination and Procedure (“MPEP”) § 2163(II)(3)(ii)(b) which also requires each claim limitation to be expressly, implicitly or inherently supported by the disclosure upon which the patent relies for its earlier filing date.

Summary of Legal Arguments

With respect to the present matter, Applicants contend that the holding of *Ex Parte Craig Heikes* is controlling authority, because the Schein Patent is a continuation-in-part of the Schein A reference. Based upon the holding of *Ex Parte Craig Heikes*, statutes, regulations and/or patent examination procedures (as set forth in the MPEP), Applicants object to and traverse the Examiner’s rejection of the pending claims, under § 102(e) and/or under § 103(a), based upon the Schein Patent, the claims in which Applicants contend (and as shown in greater detail hereinbelow) are not described and/or enabled by the Schein A reference as required by 35 U.S.C. §§ 102(e), 112 and 120.

Schein Patent Claims Subject Matter Not Described or Enabled by Schein A Reference

Applicants respectfully submit that they have thoroughly reviewed all of the independent claims in the Schein Patent against the disclosure provided in the Schein A reference. Based upon this review and the above discussed interpretation and analysis of the applicable laws, regulations and court holdings, Applicants respectfully contend that the Schein Patent is not entitled, under 35 U.S.C. 102(e), to the priority/filing date of the Schein A reference as each and every independent claim set forth in the Schein Patent includes new subject matter which is *not* described and/or enabled by the disclosure provided in the Schein A reference.

Each Claim in Schein Patent Requires a Plurality of Internet Data Sources

To begin this discussion of why the Schein Patent is not entitled to the filing date of the Schein A references, Applicants note that under 35 U.S.C. §§ 112 and 120, the specification must provide for every claimed invention a written description setting forth in “full, clear,

concise and exact terms" the manner and process of making and using such invention so as to enable any person skilled in the art to make and use the same and shall set forth the best mode contemplated by the inventor for carrying out the invention. Applicants contend that whether an inventor satisfies these requirements of clarity, conciseness, full description, enablement and best mode can be determined by comparing the elements and limitations in each independent claim, and especially those added to gain allowance of the claimed invention, against the specification upon which such §112 reliance is placed.

In making such a comparison, Applicants contend that each and every claim in the Schein Patent includes elements/limitations that were not described or enabled by the Schein A reference. One example of such an element is the claim language of "Internet data sources." This element/limitation is set forth in each of the independent claims in the Schein Patent. For example, independent claim 1 provides:

1. An interactive television system having a display screen comprising:
means for storing television schedule information;
a plurality of Internet data sources, each **data source** having a unique address;
means responsive to the television program title selecting means for searching the Internet to identify one or more **data sources** from the **plurality of Internet data sources** having data contextually related to the selected television program title;
means for selecting a **data source** from the one or more identified **data sources** having data contextually related to the selected television program title;
means responsive to the **data source** selecting means for establishing a link to the selected **data source** according to the unique address of the selected data source;
means for searching the linked **data source** for the data contextually related to the selected television program title; and

means for displaying the data from the linked **data source** on the screen.

Similarly, independent claims 17 and 19, respectively, provide:

17. A method for managing and displaying information in an interactive television system having a display screen comprising the steps of:
storing television schedule information; responsive to the television program title selection, searching the Internet to identify **one or more Internet data sources**, having data contextually related to the selected television program title;
responsive to the **data source** selecting step, establishing a link to the selected **data source**; and
displaying data from the linked **data source** on the screen.

19. An interactive television system having a display screen comprising:
means for storing;
a plurality of Internet data sources, each **data source** having a unique address;
means responsive to the television program title selecting means for searching the Internet to identify and establish a link to a **data source** having data contextually related to the selected television program title according to the unique address of the **data source**;
and
means for displaying data from the linked **data source** on the screen.

In short, all of the independent claims and thus all of the dependent claims include the “Internet data source” element/limitation.

Further, it is worth noting that this claim element of data sources being those accessible and searchable via the Internet was added during prosecution of the Schein D application and ultimately resulted in issuance of the present claims in the Schein Patent (see Office Action response of May 24, 1999 in the file wrapper for the Schein Patent). As such, Applicants contend that the term “Internet data sources” is an essential element of the claimed invention, an element for which a full, clear and concise description must be provided in order to satisfy 35 U.S.C. 112, ¶ 1.

Further, as shown hereinbelow, Applicants contend that the concept of accessing and/or searching a plurality of “Internet data sources” was first described in the Schein C provisional application, and in particular with reference to Figure 14. As mentioned above, the Schein C provisional application was filed after the earliest claimed priority date of the present application. Further, Applicants contend that the Schein A application actually taught away from the claimed invention (in the Schein Patent), of accessing a plurality of Internet data sources in order to obtain information, which relates to a title provided on a television guide.

Schein A Reference Teaches Away From Accessing a Plurality of Internet Data Sources

Applicants contend that the teaching of the Schein A reference only provides for an embodiment in which a single database is connected to or provided within a single computer. Or, stated in other words, Schein A does not teach accessing multiple Internet data sources. The fact that Schein A teaches a single database embodiment is shown in innumerable locations throughout the Schein A reference. For example, page 2 of Schein A, provides, “Fig. 1 illustrates a computer system coupled to a television system..... Fig. 7 illustrates several arrangements for providing television schedule information from a database to a television for display.” The fact that Schein A was directed to a single computer system connected to a television is further set forth on page 2, lines 34-36, which provides “[t]o provide this functionality in the preferred embodiment, the present invention includes a computer system and a television system.” The functionality to which this passage refers is the function of providing a television guide. The next three paragraphs then discuss what is meant by the “computer system.” It is the Applicants understanding that the inventors meant to teach the utilization of a

single personal computer, and not a plurality of computer systems as would arguably be necessary to provide access to a plurality of Internet data sources.

Next, Schein A discusses how the television guide, and updates thereto, are provided to the computer system. This discussion is provided with reference to Figures 5A and 6. In general, using the process set forth in Schein A, a computer program is provided on disc or downloaded from a satellite, transmitted through the Internet or otherwise from a main site or database. (See, Schein A, pg. 3, lines 28-38). While this passage does mention the Internet, Applicants contend that Schein A does not teach accessing a plurality of Internet data sources, instead it teaches accessing a single source (*e.g.*, the “main site” - see Figure 5A, block 170) which provides a computer program needed to configure one’s computer system.

On page 12 of Schein A, a discussion is then provided with reference to Figure 7. This discussion begins with “Fig. 7 illustrates several arrangements for providing television schedule information from a database to a television for display. In one embodiment, on-line information providers ... provide access to a database which contains the television schedule information.” (Schein A, Pg. 12, Lines 25-30 (emphasis added)) Applicants note that reference is provided to a single database, not to a plurality of Internet data sources. Further, Applicants contend that one skilled in the art would have appreciated that a personal computer only connects, via a modem, to only one on-line information provider at any given time. As such, while numerous on-line information providers are mentioned, the connection between the users computer system or television system is still taught as being with only a single database.

The fact that a single database is taught in Schein A is further supported by the description on page 13 which provides, “[i]n another embodiment, the database with the television schedule information is located in memory 406 within television 400....the technology that enables the television schedule information to be provided from a database to a television for display is not specific to any given data system.” (Pg. 13, Lines 13-25 (emphasis added)). Again, reference is only provided to a single database.

Further, Schein A provides that the database may also provide “information which is independent of the user’s program choice.” (Pg. 13, lines 28-30). This information is accessed, via the Services Button, “from the database” described in Schein A.

On page 14-16, Schein A discusses another embodiment wherein “a television program title and/or a program’s content could be linked to an on-line service or to an available database.” (Pg. 14, Lines 10-12 (emphasis added)). At first glance, one might interpret this passage as broadly covering a plurality of Internet data sources. However, Applicants contend that such an interpretation is an improper reading into Schein A of subject matter first disclosed in Schein C. For example, the above quoted passage merely provides linking a program title “to an on-line service or to an on-line database.” It does not provide linking to a plurality or at least one of many on-line services or databases. Further, the more detailed discussion of this embodiment provided on the remainder of pages 14 -16 teach a contrary conclusion. For example, Schein A provides that “the electronic program guide contacts and communicates with the database of available information ... contact and communication is established between the user and the database each time the available database is contacted and searched the software can search the database ...” (Pg. 15, Lines 7-34 (emphasis added)).

In summary, Applicants contend that Schein A discloses a system and/or method in which data is obtained from a single database. It does not disclose nor enable the concept of accessing a plurality of Internet data sources as required by each and every claim in the Schein Patent.

Schein et al’s First Disclosure of Internet Data Sources Occurred in Schein C Reference

Applicants further contend that the Schein C reference was the first disclosure by Schein et al of the concept of providing a plurality of Internet data sources, wherein each data source has data that is contextually related to a selected television program title. Since the terms “Internet data source” and “data sources” are not defined anywhere in the Schein Patent or in the Schein A reference, Applicants contend that one skilled in the art would interpret and understand these terms as referring to a file server connected to the Internet. Applicants assert that the concept of accessing a plurality of file servers connected to a network from a user’s computer, PCTV or other device was first disclosed by Schein et al. in Figure 10 of the Schein C reference (which is identical to Figure 14 in the Schein Patent). Importantly, Figure 10/14 was not disclosed in the Schein A reference, nor, as discussed above, was the concept of providing access to a plurality of “Internet data sources” illustrated, mentioned or fully discussed (if at all) in Schein A.

For example, Applicants contend that the detailed description section of the Schein Patent which refers to Figure 14 was new matter in the Schein C application and thus, is new matter with respect to the disclosure provided in the Schein A reference. This detailed description provides (in substantial part) as follows:

FIG. 14 illustrates a system and method for accessing television schedule information from one or more servers 350 on a computer network 360, such as the Internet or the World Wide Web....

In one embodiment, the computer network 360 includes a plurality of servers 350 and a database 370...[which] includes television schedule information ... Servers 350 represent file servers having files, databases or the like.....and each server 350 is addressable by a unique address.... For example, the servers may be assigned the domain name "invoice.com".... [and users] may access servers 350 via the WWW using WWW compatible software by indicating the system's uniform resource locator address: "HTTP://www.invoice.com".

In another embodiment, the television schedule guide may also include other information about programs, such as ratings, stars, type of movie (e.g., suspense, comedy, drama, western, musical, children, biography, horror, etc.). This information may be provided on the actual website and/or internet broadcast transmitter, or the website and/or internet broadcast transmitter may provide means for linking the viewer with other websites and/or internet broadcast transmitter to provide more information on certain topics and categories. (Schein Patent, Col. 18, Lines 7-67 (emphasis added)).

In fact, Schein et al. devoted an entire figure and at least an entire column (if not more) of text in the specification to describing how a plurality of Internet data sources could be used to provide information. Arguably, Schein et al's addition of this significant description begs the

conclusion that Schein A did not fully describe (if even at all) and at a minimum did not satisfy the enablement requirements of § 112, ¶ 1 with respect to the concept of using a plurality of Internet data sources.

A comparison of the various independent claims in the Schein Patent with the above segment taken from Column 18 of the Schein Patent, also, leads one to the conclusion that “Internet data source” refers to the servers 350 identified above (and first disclosed in Figure 10/14). For example, claim 1 in the Schein Patent provides “a plurality of Internet data sources, each data source having a unique address.” Similarly, column 18, line 27 provides “server addressable by a unique address.” Applicants believe that the term “unique address” first and only appears in Column 18 of the Schein patent and relates to the system disclosed in Figure 10/14.

As such, Applicants assert that the concept of using, selecting, identifying or accessing “a plurality of Internet data sources” was not described in and/or enabled by the Schein A reference. Instead, Applicants assert this claim element/limitation was first disclosed in Schein C, which was filed after the priority date for the present matter.

Summary of 102(e) Rejection

Accordingly, since the Schein A reference does not satisfy 35 U.S.C. 112 and other laws and regulations with respect to teaching and/or enabling the concept of using, for example, a plurality of “Internet data sources,” Applicants contend the Schein Patent can not properly be accorded the filing date of the Schein A reference.

Further, since the Applicants’ priority date of March 8, 1996 predates any other possible priority date associated with the Schein Patent, Applicants respectfully submit that the Examiner’s §102(e) rejection cannot be sustained and is improper. Accordingly, Applicants respectfully request the rejection be overturned and all of the currently pending claims be allowed.

Rejections Under 35 U.S.C. §103

The Examiner also rejected claims 2-3, 15, 20, 41, 36-37, 75, 80, 102, 110 and 141-170 under 35 U.S.C. §103(a) as being unpatentable over the Schein Patent. Applicants respectfully submit that claims 36-37 were canceled previously and thus the rejections related thereto are moot. Further, Applicants contend that claims 110, 141, and 156 (*i.e.*, the independent claims identified in the above listing) are each patentable over Schein for the reasons set forth hereinabove with respect to the Examiners § 102(e) rejection. In particular, Applicants contend that a reference which cannot be used to support a prior art rejection under 35 U.S.C. 102(e) also cannot be used as prior art under 35 U.S.C. 103(a). Applicants also contend that each of the remaining claims identified above depend from an independent claim which has been shown to be patentable over the prior art of record.

As such, Applicants respectfully request the Examiner to rescind his rejections of the above identified claims under 35 U.S.C. 103(a) as being based upon the Schein Patent, an improper reference.

Closing Remarks

Applicants contend that each and every pending claim in the present application is expressly, implicitly and/or inherently supported by the disclosure set forth in U.S. patent application serial number 08/615,143, now U.S. Patent No. 5,778,181, which was filed on March 14, 1996 and which claims priority to U.S. patent application serial number 08/613,144, which was filed on March 8, 1996. As such, Applicants contend that each and every claim pending in the present application is entitled to claim priority to a filing date of as early as, if not earlier, March 14, 1996.

Additionally, although specific reference has been made above to certain subject matter that exists in each of the claims in the Schein Patent and the various Schein references, it should be understood that these are by no means the only subject matter/elements contained within the various claims set forth in the Schein Patent that may not be enabled and/or fully described by the Schein A reference. Applicants respectfully suggest that other subject matter most likely exists in the various claims in the Schein Patent which are not supported by the Schein A

reference and/or additional subject matter, relied upon by the Examiner in issuing the various claim rejections is also unsupported by the disclosure provided by the Schein A reference. As such, Applicants reserve the right to make additional showings, as necessary, to further establish that the Schein Patent is not entitled under 102(e) to claim priority to the filing date of the Schein A reference and/or that various subject matter in the Schein Patent is not entitled to the filing date of the Schein A reference.

Applicants, however, contend that they have met their burden of showing that a prima facie case does not exist and that the burden has now shifted to the Examiner to clearly show how each claimed invention in the Schein Patent is enabled and supported by a full, clear and concise written description in the Schein A reference. Absent such showing, Applicants respectfully contend that the Schein Patent can not operate as an invalidating prior art reference, that the Examiner must withdraw the § 102(e) and 103(a) rejections, and that each and every pending claim in the present application is allowable over the prior art of record.

Last, the Applicants thank the Examiner for his thorough review of the claims in this application. In the event the Examiner has questions or comments and a telephone conversation would expedite resolution of same, the Applicants invite the Examiner to contact the undersigned attorney at (303) 260-6362.

Respectfully submitted,

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